

REMARKS

Claims 1-23 are pending and stand rejected under 35 USC §§ 102 or 103. Applicant traverses the rejections in light of the above amendments.

Applicant requests interview

Applicant respectfully requests an interview if it would expedite disposition of the application. The undersigned attorney would welcome and encourage a telephone conference with Examiner at (512) 391-4913.

Misnumbered claims

Applicant renumbered the claims as indicated in the Office action. Thus, Applicant requests that the objection be withdrawn.

Amendments to the claims and New claims

Applicant amended claims 1-24 to describe functionality of an email server to clarify distinctions from the cited art. Applicant also added claims 24-32 to describe functionality of the email client. Support for the amendments can be found in the specification at, e.g., paragraphs 15-18, 25, 28, 36, and 45, and FIGs. 1, 3, and 4. The amendments do not add new matter so Applicant respectfully requests that the amendments be entered.

Claim rejections under 35 USC § 102

Claims 1, 2, 4-6, 9-11, 14, 17-19, 21, and 22 stand rejected under 35 USC § 102(b) as being anticipated by Kohler et al., U.S. Patent Application No. 6,192,396 (hereinafter referred to as “Kohler”). Applicant respectfully traverses the rejections with respect to claims 1, 2, 4-6, 9-11, 14, 17-19, 21, and 22 with the following remarks, and the new claims 24-33.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference.¹ Furthermore, the identical invention must be shown in as complete detail as is contained in the claim.²

Independent Claims 1 and 18

With regards to Kohler, the Office action fails to establish a *prima facie* case of anticipation for independent claims 1 and 18 because Kohler fails to describe, either expressly or inherently, “each and every element as set forth in the claim”. In particular, Kohler fails to describe “identifying, by the email server, in response to receipt of the email message from the email client, an instance of the private content in the email message” and “determining, by the email server, in response to identifying the instance, an association between the instance and a recipient of the recipients”.

Kohler describes an email editor that interacts with a user to identify text or attachments with specified recipients.³ The email editor then generates separate messages for each subset of the identified recipients.⁴ In contrast, claims 1 and 18 describe an email server that receives an email message addressed to multiple recipients from an email client and, in response, identifies an instance of private content within the email message. According to claims 1 and 18, in response to identifying the instance of private content, the email server determines an association between the instance and at least one of the recipients of the message. The email server then generates emails based upon the association by redacting the instance from the email message for at least one of the emails and transmits the emails to the recipients.

In other words, Kohler does not identify, by the email server, in response to receipt of the email message from the email client, an instance of the private content in the email message. And Kohler does not determine, by the email server, in response to identifying the instance, an association between the instance and a recipient of the

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

² *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

³ Kohler col. 10, lines 55-61.

⁴ Kohler col. 11, lines 30-38.

recipients. Unlike claims 1 and 18, Kohler also significantly increases network traffic between the email editor and the email server. Kohler does not receive the email message at the email server. And Kohler does not identify an instance of private content in response to receipt of the email message. Thus, Kohler does not describe “the identical invention [which] must be shown in as complete detail as is contained in the claim”⁵ for anticipation of claims 1 and 18. Applicant traverses the rejection and requests that claims 1 and 18 be allowed.

Independent Claim 10

With regards to Kohler, the Office action fails to establish a *prima facie* case of anticipation for independent claim 10 because Kohler fails to describe, either expressly or inherently, “each and every element as set forth in the claim”. In particular, Kohler fails to describe “a content identifier to receive the email message from an email client and, in response, to identify one or more instances of private content in the email message” and “a content associator to determine an association between at least one instance and a first set of one or more of the recipients and to associate remaining instances, if any, with additional sets of the recipients.”

Kohler describes an email editor that interacts with a user to identify text or attachments with specified recipients.⁶ The email editor then generates separate messages for each subset of the identified recipients.⁷ In contrast, claim 10 describes an email server that receives an email message addressed to multiple recipients from an email client and, in response, identifies an instance of private content within the email message. According to claim 10, in response to identifying the instance of private content, the email server determines an association between the instance and at least one of the recipients of the message. According to claim 10, the email server then generates emails based upon the association by redacting the instance from the email message for at least one of the emails and transmits the emails to the recipients.

⁵ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

⁶ Kohler col. 10, lines 55-61.

⁷ Kohler col. 11, lines 30-38.

In other words, Kohler does not describe, explicitly or inherently, an email server to identify an instance of the private content in the email message in response to receipt of the email message from the email client. And Kohler does not describe, explicitly or inherently, an email server to determine an association between the instance and a recipient of the recipients in response to identifying the instance. Thus, Kohler does not describe “the identical invention [which] must be shown in as complete detail as is contained in the claim”⁸ for anticipation of claim 10. Applicant traverses the rejection and requests that claim 10 be allowed.

Independent Claim 24

With regards to Kohler, the Office action fails to establish a *prima facie* case of anticipation for independent claim 24 because Kohler fails to describe, either expressly or inherently, “each and every element as set forth in the claim”. In particular, Kohler fails to describe:

...transmitting, by the email client to an email server, the email message with one or more portions of the email message identified as private content and an association between the instance of the private content and the recipient, for generation, by the email server, of at least one email comprising the email message with the private content and at least one email comprising the email message excluding the private content.

Kohler describes an email editor that interacts with a user to identify text or attachments with specified recipients.⁹ The email editor then generates separate messages for each subset of the identified recipients.¹⁰ In contrast, claim 24 describes an email client that transmits, to an email server, a message identifying private content and an association between an instance of the private content and a recipient. Kohler does not identify an instance of private content in response to receipt of the email message. And Kohler does not transmit the email message by the email client to an email server, the email message with one or more portions of the email message identified as private.

⁸ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

⁹ Kohler col. 10, lines 55-61.

¹⁰ Kohler col. 11, lines 30-38.

content and an association between the instance of the private content and the recipient. Thus, Kohler does not describe “the identical invention [which] must be shown in as complete detail as is contained in the claim”¹¹ for anticipation of claim 24. Applicant respectfully requests that claim 24 be allowed.

Independent Claim 29

With regards to Kohler, the Office action fails to establish a *prima facie* case of anticipation for independent claim 29 because Kohler fails to describe, either expressly or inherently, “each and every element as set forth in the claim”. In particular, Kohler fails to describe:

...the email client to transmit the email message to an email server, the email message having one or more portions identified as private content and an association between the instance of the private content and the recipient, for generation, by the email server, of at least one email comprising the email message with the private content and at least one email comprising the email message excluding the private content.

Kohler describes an email editor that interacts with a user to identify text or attachments with specified recipients.¹² The email editor then generates separate messages for each subset of the identified recipients.¹³ In contrast, claim 29 describes an email client that transmits the email message to an email server, the email message having one or more portions identified as private content and an association between the instance of the private content and the recipient. And Kohler does not transmit the email message to an email server, the email message having one or more portions identified as private content and an association between the instance of the private content and the recipient. Thus, Kohler does not describe “the identical invention [which] must be shown in as complete detail as is contained in the claim”¹⁴ for anticipation of claim 29. Applicant respectfully requests that claim 29 be allowed.

¹¹ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

¹² Kohler col. 10, lines 55-61.

¹³ Kohler col. 11, lines 30-38.

¹⁴ *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Dependent Claims

Further, claims dependent upon independent claims 1, 10, 18, 24, and 29, incorporate the limitations of the respective independent claims. As discussed above, Kohler does not anticipate claims 1, 10, 18, 24, and 29. Thus, Kohler does not describe, explicitly or inherently, all the limitations of the dependent claims. Applicant respectfully requests that the rejection of dependent claims be withdrawn and that dependent claims be allowed.

Claim rejections under 35 USC § 103(a)

The Office action further rejected claims 3, 12, and 20 under 35 USC § 103(a) as being unpatentable over Kohler in view of Drexler, claims 7, 13, and 15 as being unpatentable over Kohler in view of Altavilla, and claims 8, 16, and 23 as being unpatentable over Kohler in view of Rafal.

To establish a *prima facie* case of obviousness, the modification or combination must teach or suggest all of Applicants' claim limitations.¹⁵

The claims dependent upon independent claims 1, 10, 18, 24, and 29, incorporate the limitations of the respective independent claims. The rejections of claims under 35 USC § 103(a) are predicated on Kohler to teach or suggest the limitations of independent claims 1, 10, 18, 24, and 29. As discussed above, Kohler does not describe the limitations of claims 1, 10, 18, 24, and 29. Applicant submits that Kohler does not teach or suggest the limitations of claims 1, 10, 18, 24, and 29 for the same reasons stated above. Thus, the combinations of Kohler with Drexler, Altavilla, and Rafal do not teach or suggest all the limitations of the dependent claims. Applicant respectfully traverses the rejections, requests that the rejection of dependent claims be withdrawn, and requests that dependent claims be allowed.

Furthermore, with regards to claims 8, 16, and 23, the combination fails to teach or suggest the use of hypertext markup language code to display the instance within

¹⁵ *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974).

emails addressed to recipients associated with the instance and to redact the instance in emails addressed to other recipients. Applicant herein traverses these rejections. Kohler teaches or suggests identifying text or attachments and associating the text or attachments with recipients. Rafal teaches or suggests the use of hypertext markup language code to include “decorations” in an email. Assuming, in arguendo that the references can be combined, the combination of Kohler and Rafal teaches or suggests the use of hypertext markup language code to include decorations in emails generated for recipients and the emails may include text or attachments associated with the recipients. The combination teaches or suggests hypertext markup language code to insert “decorations” in every email and does not teach or suggest the exclusion of private content from displays of an email message based upon the routing of the email. Thus, Applicant respectfully requests that the rejection of claims 8, 16, and 23 be withdrawn and that claims 8, 16, and 23 be allowed.

Still further, the combinations of Kohler with Drexler, Altavilla, and Rafal do not teach or suggest all the limitations of the new dependent claims 26 and 31. Neither Kohler, Drexler, Altavilla, nor Rafal teach or suggest that selection within the email header of a recipient of an email message causes generation of a preview of resulting content for a recipient. Thus, Applicant respectfully requests that the claims 26 and 23 be allowed.

CONCLUSION

Applicant respectfully traverses the cited reference in regards to the claim rejections of the claims under 35 USC §§ 102 and 103. Accordingly, Applicant believes that this response constitutes a complete response to each of the issues raised in the Office action. In light of the accompanying remarks, Applicant believes that the pending claims are in condition for allowance. Thus, Applicant requests that the rejections be withdrawn, pending claims be allowed, and application advance toward issuance.

A request for an extension and the corresponding fees accompany this filing. Authorization for fees for additional claims accompany this filing. No other fee is believed due with this paper. However, if any fee is determined to be required, the Office is authorized to charge Deposit Account 09-0447 for any such required fee.

Respectfully submitted,

January 15, 2008

/Jeffrey S Schubert/

Date

Jeffrey S. Schubert, reg. no. 43098, cust. no.: 45557
Schubert Osterrieder & Nickelson PLLC
One Congress Pl, 111 Congress Ave, 4th fl, ste 403
Austin, Texas 78701
512.692.7297 (tel) 512.301.7301 (fax)
Jeff.Schubert@sonlaw.com, http://www.sonlaw.com
Attorney for Applicant(s)